

REMARKS

Applicant respectfully requests reconsideration. Claims 1-18 were previously pending in this application. Claim 13 has been canceled and claims 11, 14, 17 and 18 have been amended. New claims 19-21 have been added. As a result, claims 1-12, and 14-21 are pending for examination with claims 1, 4, and 7 being independent claims. No new matter has been added.

Summary of Telephone Conference with Examiner

Applicant wishes to thank Examiner Green for the opportunity to conduct a telephone interview with Shannon Pratt on June 22, 2005. During the interview, the claim rejections in view of the combination of Quant and Bowder were discussed. The substance of the discussion is incorporated into the following remarks.

Objections to the Specification

The specification is objected to for failure to provide proper antecedent basis for claims 1, 16 and 18, which recite a pressure member that includes a middle portion which is substantially parallel to the back panel. Applicants have amended the specification on pages 3-4 to provide explicit support for these claims. Support for this amendment may be found in the application as filed at least in FIGS. 5 and 8.

Accordingly, withdrawal of this objection to the specification is respectfully requested.

Objections to the Claims

The claims are objected to for several informalities. In particular, the Examiner suggests that "the pressure member" recited various times in claim 11, 13, 14, 17 and 18 should be amended to recite, "the at least one pressure member", as defined in independent claim 7. Applicant has canceled claim 13, and has amended claims 11, 14, 17, and 18 in the manner suggested by the Examiner to further the prosecution of this application.

Accordingly, withdrawal of this objection to claims 11, 13, 14, 17, and 18 is respectfully requested.

Rejections Under 35 U.S.C. §103

Claims 4-8, 10-14, and 16-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Quant (U.S. Patent No. 2,221926) in view of Bowder (U.S. Patent No. 2,550,763).

Quant is directed to a character bearing device that holds various types of letters, numerals and insignia. The device includes a channel-shaped holder 10 having a flat base 11 with flanges 12. The device also includes a locking plate 14 with a plurality of upwardly extending spring locking fingers 16 all inclined towards one end of the locking plate 14. The characters 17 slide into the channel and the back of the characters 17 have slots 19 that have a width smaller than the width of the spring locking fingers 16. When the characters 17 slide into the channel, the locking fingers 16 lock the characters into the holder. To remove the characters from the holder, a release bar 20 is inserted into the slot formed in the back of the characters which depresses the locking fingers 16 out of engagement with the characters 17 such that the characters may be slid out of the holder.

Recognizing that Quant does not disclose a pressure member having a smooth camming surface at each end of the pressure member, as recited in independent claim 4, or at least a pair of rectangular openings within the back panel defining at least one pressure member that bows forwardly at each end of the pressure member, as recited in independent claim 7, the Examiner has looked to Bowder to cure this deficiency. Bowder discloses an identification assembly unit with letters that slide into a carrier 16. A spring 28 rests on top of the bottom wall 25 of the carrier 16 and has a natural contour bulging upwardly. The Examiner contends that it would have been obvious to modify Quant by replacing the multiple locking fingers 16 with a single spring 28 because this would allow the device to "be made in an easier and less expensive manner and would allow the indicia to be biased in a more even manner." Applicants respectfully disagree.

To establish a prima facie case of obviousness under §103 based on modifying a reference, "there must be some suggestion or motivation to modify the reference or to combine the reference teachings, and there must be a reasonable expectation of success." M.P.E.P §2143 and §2143.02. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in the applicants' disclosure." MPEP §2143. See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, if the

“proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification”. MPEP §2143. See In re Gordon, 733 F.2d 488, 900 USPQ 1125 (Fed. Cir. 1984). Applicants respectfully submit that the Office Action has failed to establish a reasonable expectation of success, and that the modification of Quant in view of Bowder as suggested by the Examiner would make the Quant device unsatisfactory for its intended purpose.

Quant teaches using cantilevered locking fingers 16 where the open end of the cantilever structure is depressed with the release bar 20 to remove characters from the channel. It does not appear that the release bar in Quant would operate without a cantilever shaped locking finger. However, Bowder teaches a spring 28 having a V-shape or a U-shape (see Fig. 4). Due to the shape and configuration of the spring 28 in Bowder, it is unclear how the Quant device could be modified to have the shape of the spring 28 in Bowder, without rendering the release bar 20 in Quant inoperable. Based upon the information provided in Quant and Bowder, it would seem that a release bar 20 as taught in Quant would push up against and bend the spring 28 of Bowder, rather than slide over the spring to depress. Thus, the release bar 20 of Quant would not be able to remove characters from the device. It is well settled that if such a proposed modification of a prior invention is unsatisfactory for its intended purpose, then there is no suggestion or motivation to make such a modification.

Therefore, it is respectfully requested that the Examiner withdraw the rejection of independent claims 4 and 7 in view of Quant and Bowder, as the prior art fails to teach at least these recitations of claims 4 and 7. Claims 5, 6, and 16, depending on claim 4, and claims 8, 10-14, 17, and 18 depending from claim 7 are allowable for at least the same reasons.

It is further noted that, notwithstanding the foregoing and for the sake of argument only, even were one of ordinary skill in the art to somehow have been motivated to employ the spring 28 of Bowder with the Quant device, independent claim 7 patentably distinguish over the combination. Quant and Bowder, taken alone or together, do not disclose at least one pair of rectangular openings within the back panel defining between them the at least one pressure member, as recited in claim 7. As shown in Fig. 6 in Quant, the locking fingers employed in Quant are formed with a U-shaped opening. Assuming that the locking fingers in Quant is the pressure member, Quant does not disclose at least one pair of rectangular openings within the back panel defining between them the at least one pressure member, as recited in claim 7.

Further, even if one were to assume that the spring 28 of Bowder is the pressure member, there is no pair of rectangular openings within the back panel defining between them the at least one pressure member, as recited in claim 7. As shown in Fig. 5 of Bowder, the spring 28 extends over the bottom 25 of the carrier. This is also illustrated in the section views of Figs. 2 and 4, which show that the spring 28 rests on top of the carrier, and is not integral with the carrier. In essence, the spring 28 in Bowder appears to be an extruded component attached to the end of the carrier. Accordingly, there are no rectangular openings in the panel defining a pressure member, as recited in claim 7. Thus, claim 7 patentably distinguishes over the combination of Quant and Bowder, such that the rejection under §103 is improper and should be withdrawn.

Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Quant in view of Bowder, and further in view of Harn (U.S. Patent No. 3,192,655) or Elkies (U.S. Patent No. 2,495,577).

Without acceding to the propriety of the reference combination nor the rejection grounded thereon, claim 9 depends from independent claim 7 and is patentable for at least the same reasons set forth above. Accordingly, the rejection of this claim over Quant in view of Bowder and further in view of Harn or Elkie should be withdrawn.

Claims 1-3, and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Quant in view of Bowder, and further in view of Harn or Elkies.

Quant and Bowder are discussed above. Recognizing that Quant does not teach or suggest a pressure member constructed and arranged to bow out of the back panel in a forward direction at each end of the pressure member extending to a middle section which is substantially parallel to the back panel, as recited in independent claim 1, the Examiner has looked to Bowder to cure this deficiency. Further, Quant does not teach or suggest a pin and clasp system, as recited in independent claim 1. Therefore, the Examiner looks to both Harn and Elkies which disclose an attachment member in the form of a pin and clasp.

As described above, Applicant contends that there is no motivation to combine Quant with Bowder because the proposed modification to the device in Quant would render Quant unsatisfactory for its intended purpose. More particularly, if Quant was modified such that the

locking fingers bow out of the back panel in a forward direction at each end of the locking finger, the release bar 20 in Quant would not function to depress the locking fingers.

Therefore, it is respectfully requested that the Examiner withdraw the rejection of independent claim 1 in view of Quant, Bowder, and Harn or Elkies, as the prior art fails to teach at least these recitations of claim 1. Claims 2, 3, and 15, depending on claim 1 are allowable for at least the same reasons.

New Claims

Applicant has added new dependent claims 19-21 to further define the invention. Support for these new claims may be found at least on page 3, line 21 – page 4, line 6, and also in FIGS. 5-8. No new matter has been added.

New dependent claim 19 is directed to an award bar and holder where the middle section of the pressure member is substantially parallel to the back panel *before an award bar is disposed in the slide seat*. This further distinguishes over the combination of Quant and Bowder because as shown in Fig. 2 and 4 in Bowder, when there is no load bearing device, such as a letter or character 30 positioned above the spring 28, the spring 28 protrudes out having a V-shape. In Bowder, it is only when a character 30 is pressing down on the spring in the device that the spring has a middle section which may be substantially parallel to the bottom 25 of the tray.

New dependent claims 20 and 21 are directed to an award bar and holder where each end of the pressure member extends out in a direction non-parallel with each other. This further distinguishes over the combination of Quant and Bowder because, for the sake of argument only, even if one of skill in the art would have been motivated to combine Quant with Bowder, in order for the release bar 20 of Quant to be able to function to depress the locking fingers 16 down to an unlock position, each end of the locking finger would have to be substantially parallel to each other (like the configuration of Quant). An arrangement where the ends of the locking fingers extended in a non-parallel relationship would not permit the release bar 20 of Quant to function.

Accordingly, new dependents claim 19-21 should be allowable for at least these reasons.

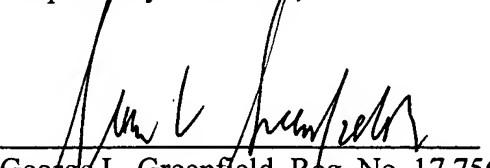
CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

By:


George L. Greenfield, Reg. No. 17,756
Shannon Pratt, Reg. No. 55,548
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
Telephone: (617) 646-8000

Docket No.: B0227.70000US00

Date: July 5, 2005

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